

R E M A R K S

Attention is respectfully directed to the attached certified English-language translations of applicants' Japanese patent applications No. 2003-010391 filed January 17, 2003, and No. 2003-371031 filed October 30, 2003. The priority benefit of both Japanese applications under 35 U.S.C. §119 has been claimed and certified copies thereof have been filed in the present application, as acknowledged in the Office Action dated August 3, 2006.

Claim 1 has been amended to incorporate the recitals of original dependent claims 3, 7 and 8, which have accordingly been cancelled as redundant. The dependence of claims 4, 5 and 9 has been changed in view of the cancellation of claim 3. Since this Amendment does not increase either the total number of claims or the number of independent claims, no additional fee is necessary.

Claims 1 (independent; amended), and 2, 4 - 6 and 9 - 12 (dependent), all directed to initialization methods, are in the application. No claim has been allowed.

Rejections on Deguchi et al. '875

Claims 1, 2, 4 - 6 and 9 - 11 have been rejected under 35 U.S.C. §102(e) as anticipated by U.S. patent No. 7,063,875 (Deguchi et al. '875)¹ and claims 1, 2, 4 - 6 and 9 - 12 have been rejected under 35 U.S.C. §103(a) as unpatentable over Deguchi et al. '875 in view of U.S. patent No. 5,870,375 (Maeda et al. '375).

Deguchi et al. '875, however, is not a reference against the present application under §102(e). The inventive entities in Deguchi et al. '875 and in the present application are identical,

¹In the text of the Office Action, the last two digits of the patent number are transposed to read "Deguchi et al. '857," but it is clear that the applied citation is in fact patent No. 7,063,875 of Deguchi et al. See Form PTO-892 attached to the Action; also, compare the Examiner's column/line citations to the '875 patent.

i.e., the same nine persons, although listed in different orders in the two cases. In order to qualify as a reference under §102(e), a citation must be a publication of a U.S. patent application by *another* or a U.S. patent granted on an application by *another*. An inventive entity consisting of exactly the same persons as that of the present application is not "another," regardless of the order in which the persons may be listed. Consequently, no claim of the present application can be rejected either on Deguchi et al. '875 under §102(e) or on Deguchi et al. '875 in view of Maeda et al. '375 under §102(e)/§103(a).

Rejection on Yuzurihara et al. '447

Claims 1, 2, 4 - 6 and 9 - 11 have been rejected under 35 U.S.C. §102(e) as anticipated by U.S. patent application publication No. 2004/0141447 A1 (Yuzurihara et al. '447), published July 22, 2004, as a publication of application No. 10/730,922 filed in the U.S. on December 10, 2003. Yuzurihara et al. '447 does not claim the benefit of any earlier U.S. filing date.

The present application claims the priority benefit, under 35 U.S.C. §119, of two Japanese patent applications respectively filed on January 17 and October 30, 2003. As mentioned above, certified copies of both of these Japanese priority applications have been filed in the present application (and acknowledged by the Examiner), and certified English-language translations of both of these Japanese priority applications are attached hereto.

The filing dates of applicants' two Japanese priority applications are both earlier than December 10, 2003, the effective date of Yuzurihara '447 as a reference under §102(e).

In particular, it is submitted that applicants' earliest Japanese priority application, No. 2003-010391 filed January 17, 2003, fully supports all of present claims 1, 2, 4 - 6 and 9 - 11 as herein amended. See the claims at pp. 3-5 of the translation

(noting that translation claims 3, 7 and 8 support the recitals added by this Amendment to present claim 1), together with the disclosure of the second protective layer and reflective layer at p. 5, line 32 - p. 6, line 5, p. 15, lines 29-32, and p. 26, lines 25-31 of the translation. For $1 \leq \gamma < 9$ when at least one of α and $\beta > 0$ (present claim 1), see $1 \leq \gamma \leq 10$, and $5 \leq \alpha + \beta + \gamma \leq 9$ when at least one of α and $\beta > 0$, in claim 1 of the translation.² For 20 nm as the upper limit of oxide layer thickness (present claim 9), see Example 6 at p. 30, lines 19-29, in the translation.

It is therefore further submitted that applicants' claimed right to the priority of Japanese application No. 2003-010391 overcomes Yuzurihara et al. '447 as a reference against all of present claims 1, 2, 4 - 6 and 9 - 11 as herein amended.

Rejection on Sawada et al. '488

Claims 1, 2, 4 and 9 - 11 have been rejected under 35 U.S.C. §102(e) as anticipated by U.S. patent application publication No. 2004/0114488 A1 (Sawada et al. '488), which was published June 17, 2004, as a publication of application No. 10/694,939 filed in the U.S. on October 29, 2003. Sawada et al. '488 does not claim the benefit of any earlier U.S. filing date.

Initially it may be noted that original dependent claims 7 and 8 were not rejected on Sawada et al. '488. The features set forth in those claims, viz., that the oxide layer further comprises at least one of a rare earth oxide and an oxide of a group IIa element exclusive of Be, and that a content of the at least one of the rare earth oxide and the oxide of a group IIa element exclusive of Be ranges from 1 to 10 mole % based on ZrO_2 , have been incorporated in claim 1 by the present Amendment. These features are not even assertedly disclosed or suggested by Sawada et al. '488. Their

²If $\alpha + \beta + \gamma \leq 9$ when α and/or $\beta > 0$, γ must be < 9 .

recital is, therefore, submitted to distinguish amended claim 1 (and claims 2, 4 and 9 - 11, dependent thereon) patentably over Sawada et al. '488.

In addition, the filing date of applicants' earliest Japanese priority application, No. 2003-010391 filed January 17, 2003, is earlier than October 29, 2003, the effective date of Sawada et al. '488 as a reference under §102(e). As explained above, it is believed that this Japanese priority application No. 2003-010391 fully supports all of present claims 1, 2, 4 and 9 - 11 as herein amended. It is therefore further submitted that applicants' claimed right to the priority of Japanese application No. 2003-010391 overcomes Sawada et al. '488 as a reference against all of claims 1, 2, 4 and 9 - 11 of the present application as herein amended.

Additional Rejection under §103(a)

Claims 1, 10 and 11 have been rejected under 35 U.S.C. §103(a) as unpatentable over JP 10-055539 (Ebina et al. '539) in view of U.S. patent application publication No. 2004/0190407 (Nobukuni et al. '407) or EP 1 260 973 (Harigaya et al. '973).

In response to this ground of rejection, it is believed sufficient to note that none of original dependent claims 3, 7 and 8 were rejected on the asserted combination of references, and that the recitals of those three claims, viz.,

"wherein the phase change optical recording medium further comprises an oxide layer which comprises at least ZrO_2 and which is located in at least one of a position between the recording layer and the first protective layer and a position between the recording layer and the second protective layer, wherein the oxide layer further comprises at least one of a rare earth oxide and an oxide of a group IIa element exclusive of Be, and wherein a

content of said at least one of the rare earth oxide and the oxide of a group IIa element exclusive of Be ranges from 1 to 10 mole % based on ZrO_2 "

have been incorporated in claim 1 by the present Amendment. Since the three applied references, combined as proposed by the Examiner, do not even assertedly make obvious this combination of features now recited in amended claim 1, it is submitted that the quoted recital distinguishes claim 1 (and claims 10 and 11, dependent thereon) patentably over Ebina et al. '539, Nobukuni et al. '407 and Harigaya et al. '973, however combined.

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For the foregoing reasons, it is believed that this application is now in condition for allowance. Favorable action thereon is accordingly courteously requested.

Respectfully,

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I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to Commissioner for Patents, P, O, Bx 1450, Alexandria, VA 22313-1450.

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